



61

AP/IAW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : **Confirmation No. 3564**  
Sadanobu SHIRAI et al. : Attorney Docket No. 2005\_0152A  
Serial No. 10/524,858 : Group Art Unit 1615  
Filed February 18, 2005 : Examiner Hasan Syed Ahmed  
PATCHES CONTAINING TULOButEROL : **Mail Stop: Amendment**

---

**REQUEST FOR NEW OFFICE ACTION AND**  
**RESETTING DATE FOR RESPONSE**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

THE COMMISSIONER IS AUTHORIZED  
TO CHARGE ANY DEFICIENCY IN THE  
FEE FOR THIS PAPER TO DEPOSIT  
ACCOUNT NO. 23-0975.

Sir:

In the Office Action mailed June 24, 2009, the Examiner rejects claims 1-4 under the first paragraph of 35 U.S.C. §112, for lack of support for the limitation "other than an acrylic adhesive" previously introduced into claim 1.

In item 2 beginning toward the bottom of page 5 of the Office Action, the Examiner ignores this limitation in determining patentability over the references applied in the prior art rejection. But according to MPEP 2163.06: "The examiner should still consider the subject matter added to the claim in making rejections based on prior art since the new matter rejection may be overcome by applicant."

In view of this, Applicants submit that the Examiner must issue a new Office Action, taking into account the limitation "other than an acrylic adhesive" in claim 1, in setting forth the prior art rejection. It is Applicants' position that this limitation renders the claimed subject matter patentable over the applied references. The Examiner must address this argument.